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|                                     |   |                      |
|-------------------------------------|---|----------------------|
| In re Application of                | : |                      |
| Flax, Solomon                       | : | DECISION ON          |
| Application No.: 09/830,830         | : |                      |
| PCT No.: PCT/IL00/00513             | : | PETITION             |
| Int. Filing Date: 29 August 2000    | : |                      |
| Priority Date: 30 August 1999       | : | UNDER 37 CFR 1.47(b) |
| Attorney's Docket No.: 082845000000 | : |                      |
| For: PROCESS FOR PRODUCING METAL-   | : | AND 1.137(b)         |
| CONTAINING SULFIDORES               | : |                      |

This decision is in response to applicant's "PETITION UNDER 37 CFR 1.47(b) NONSIGNING INVENTOR AND PETITION FOR REVIVAL OF AN APPLICATION ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b) " filed on 28 February 2002, which seeks both the acceptance of the application without the signature of the inventor Dr. Solomon Flax and revival of the above application under 37 CFR 1.137(b).

#### BACKGROUND

On 29 August 2000, applicant filed international application PCT/IL00/00513, which claimed priority of an earlier Israel application filed 30 August 1999. A copy of the international application was transmitted to the United States from the International Bureau on 08 March 2001. A Demand does not appeared to have been filed in this application as advised by the International Bureau on 12 June 2002 that the application is still in Chapter 1. Accordingly, the twenty-month period for paying the basic national fee in the United States expired at midnight on 30 April 2001.

On 30 August 2001, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1). No oath or declaration was submitted at such time.

On 12 October 2001, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 indicating that "the current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917." The notification also indicated that the surcharge for filing the oath or declaration later than 30 months from the priority date as required by 37 CFR 1.492(e) must be filed. The notification set two months from the date of this notice or 32 months from the priority date for the application, whichever is later. Failure to properly respond will result in abandonment."

In an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4), applicant filed, *inter alia*, on 28 February 2002, the following:

- 1) a petition under 37 CFR 1.47(b);
- 2) a Declaration, Power of Attorney signed by Mr. John Omes, Managing Director;
- 3) the required petition fee; and
- 4) a petition for revival under 37 CFR 1.137(b).

**PETITION UNDER 37 CFR 1.47(b):**

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Applicant has satisfied items (1), (3), (5) and (6), but not items (2), and (4) thus not completing the requirements under 37 CFR 1.47(b).

Applicant has satisfied item (1) since the petition fee has been provided.

Regarding requirement (2), although applicant has concluded that Dr. Flax has refused to sign the declaration the petition does not include sufficient proof to establish that inventor Dr. Flax has refused to execute the application. The standards for proof are set forth in MPEP § 409.03(d), which provides:

... Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the non - signing inventor, or, if the non - signing inventor is represented by counsel, to the address of the non - signing inventor's attorney. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

Notwithstanding the statements to the contrary, it does not appear that Gilbert Goller made a bona fide attempt to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing joint inventor Dr. Flax, and that after presentation of the complete copy Dr. Flax refused to sign the Declaration. Mr. Goller declares that Dr. Flax visited his office to discuss another patent application and at that time Mr. Goller asked Dr. Flax to execute the forms for US Application 09/830,830. Mr. Goller then states that Dr. Flax made an express oral refusal to execute the documents for US application 09/830,830 or any other forms relating to this matter. Goller's Declaration at ¶ 1, 2 and 3. However, these forms do not satisfy the requirement of section 409.03(d) because a complete copy of the application (i.e., specification, including claims and drawings) does not appear to have been presented to Dr. Flax for reviewing and signing.

In the present instance, it is not clear whether a complete set of application papers were presented to Dr. Flax to sign. It is noted that no documentary evidence has been introduced into the file record that Dr. Flax was presented with the complete application. Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature. It would appear, from Mr. Goller's statement that Dr. Flax was only given the declaration to sign and not a complete copy of the application.

Regarding item (3), applicant has stated the last known address of the nonsigning inventor, which is Rechov Neva Yaacov 102/5, Jerusalem, Israel 98350.

Regarding item (4) a declaration has been provided executed by Mr. John Omes, Managing Director JOMA CHEMICALS AS, stating that he is authorized to sign on behalf of the corporation for the non-signing sole inventor, Dr. Flax, but it has not been yet established that JOMA CHEMICAL AS is the assignee. In addition, copies of the assignment document were not provided with the petition.

Regarding item (5) applicant has submitted proof that applicant has sufficient proprietary interest in the application because of Section 132 of the Israel Patent Law 1967 and an Affidavit of Gideon Kahana explaining it (both included with the petition). This agreement acknowledges ownership of the invention by SATEC ECOCHEM LTD.

Regarding item (6) applicant has presented an adequate showing that the granting of this petition is necessary to preserve the rights of the parties or to prevent irreparable damage that will result if the present patent application is deemed abandoned for failure to submit a signed Oath or declaration of the Inventor.

Because items (2), and (4) have not been satisfied, it is not appropriate to accord the national stage application status under 37 CFR 1.47(b) at this time.

### **DECISION**

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

### **PETITION UNDER 37 CFR 137(b):**

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application; (2) the petition fee as set forth in § 1.17(m); and (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Petitioner has provided: (2) the petition fee set forth in §1.17(m) and (3) the proper statement under 137(b)(3). With respect to item (4), in this application no terminal disclaimer is required.

With respect to item (1), petitioner has not provided the proper reply because a proper executed declaration has not been submitted.

Accordingly, the petition is deemed to not to satisfy requirement (1) under 37 CFR 1.137(b).

### **DECISION**

The petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

### **CONCLUSION**

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

The petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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